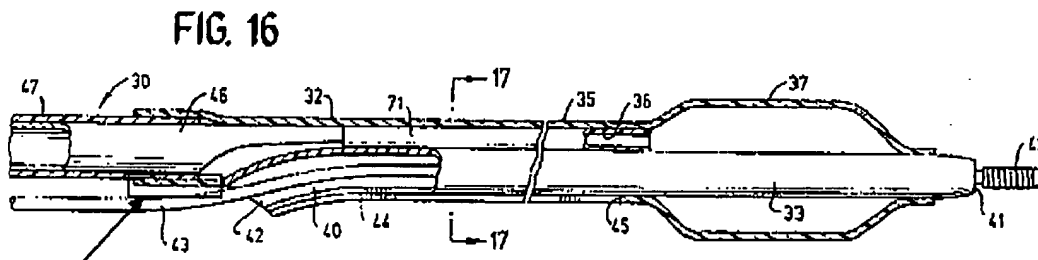


### Remarks

Favorable reconsideration is respectfully requested in light of the above amendments and the following comments. Claims 75-100 have been canceled. New claims 101-109 have been added to more fully define the scope of protection. No new matter has been added, as these new claims are fully supported by the originally filed application. Please see, for example, the Summary of the Invention, which describes a tri-layer second tube.

In response to the Appeal Brief filed July 1, 2004, the Examiner has reopened prosecution, and has allegedly provided new grounds of rejection. Applicants are somewhat confused by this, as the Examiner appears merely to have maintained the previous rejections. The only new aspect to any of these rejections, aside from the minor addition of two dependent claims to one of the rejections, appears to be that the Examiner has provided a new (but still incorrect) interpretation of the primary reference.

In the instant Action, the Examiner still relies upon Sirhan et al. to disclose a catheter shaft having a bonding region in which an outer surface of a second tube is bonded to an outer surface of a first tube. In particular, the Examiner appears to be relying, at least in part, upon Figure 16 of Sirhan et al. This Figure is reproduced below.



In the instant Action, the Examiner has asserted that elements 32 and 47 read upon the claimed first tube, while elements 33 and the small layer overlying element 47 read upon the claimed second tube. Presumably, the boxed portion above, with the arrow leading to it, is the layer overlying element 47 to which the Examiner refers. To the inexperienced eye, it may appear that this element does indeed qualify, in combination with element 33, as the claimed second tube. This is not correct, however.

In cross-sectional views, differing cross-hatching patterns are employed to indicate that different elements are formed of differing materials, or at least that different elements are in fact

different. In reviewing Figure 16, however, one of ordinary skill in the art will recognize that the cited layer overlying element 47 has a cross-hatching pattern that matches the cross-hatching pattern shown in element 32. Thus, the cited layer overlying element 47 is in fact part of element 32.

As shown in Figure 16, it can be seen that the upper portion of element 32 continues distally and forms part of the balloon 37. The lower portion of element 32 forms part of the balloon 37 and continues proximally. It is noted that the cross-hatching is not visible in the lower portion of element 32 proximal of point 45, as a result of slot 44 being formed in both elements 32 and 33. The lower portion of element 32 is interrupted by aperture 42, but continues proximally to form the cited layer overlying element 47, as cited by the Examiner.

One of skill in the art, possessing even a rudimentary knowledge of catheter construction, will recognize that the catheter shown in Figure 16 is formed by forming aperture 42 within element 32, and then inserting element 33 into aperture 42. Clearly, the proximal end of element 33 coincides with aperture 42 formed within element 32, as evidenced by the butt joint positioned there and discussed in the aforementioned Appeal Brief. Thus, no portion of element 33 extends proximally of aperture 42 and therefore no portion of element 33 can be considered as positioned such that an outer surface of element 33 could be bonded to an outer surface of element 32 (or element 47). As noted above, the portion cited by the Examiner as extending proximally of aperture 42 is in fact part of element 32.

Quite simply, Sirhan et al. do not describe disclose a catheter shaft having a bonding region in which an outer surface of a second tube is bonded to an outer surface of a first tube. Any assertion to the contrary is incorrect.

Applicants respectfully traverse the Examiner's rejection of claims 49-56, 61-64, 67, 69 and 73 under 35 U.S.C. §103(a) as unpatentable over Sirhan et al. (U.S. Patent No. 5,743,875) in view of Fontirroche et al. (U.S. Patent No. 5,538,510). As described above, Sirhan et al. fail to describe a catheter shaft having a bonding region in which an outer surface of a second tube is bonded to an outer surface of a first tube. As Fontirroche et al. do not remedy this noted shortcoming of Sirhan et al., the cited combination fails to describe every claimed element. Consequently, the *prima facie* obviousness rejection is flawed and should be withdrawn. Favorable reconsideration is respectfully requested.

Applicants respectfully traverse the Examiner's rejection of claims 57, 60, 66, 68, 70, 72 and 74 under 35 U.S.C. §103(a) as unpatentable over Sirhan et al. (U.S. Patent No. 5,743,875) in view of Fontirroche et al. (U.S. Patent No. 5,538,510) and further in view of Berg et al. (U.S. Patent No. 5,792,116). Sirhan et al. and Fontirroche et al. are distinguished above as failing to teach the claimed invention. Berg et al. also fail to remedy the noted shortcomings of Sirhan et al., and thus once again the *prima facie* obviousness rejection is flawed and should be withdrawn. Favorable reconsideration is respectfully requested.

Applicants respectfully traverse the Examiner's rejection of claims 58, 59, 65 and 71 under 35 U.S.C. §103(a) as unpatentable over Sirhan et al. (U.S. Patent No. 5,743,875) in view of Fontirroche et al. (U.S. Patent No. 5,538,510) and further in review of Javier, Jr. (U.S. Patent No. 6,093,177). Sirhan et al. and Fontirroche et al. are distinguished above as failing to teach the claimed invention. Javier, Jr. also fails to remedy the noted shortcomings of Sirhan et al., and thus once again the *prima facie* obviousness rejection is flawed and should be withdrawn. Favorable reconsideration is respectfully requested.

Applicants respectfully traverse the Examiner's rejection of claims 60 and 72 under 35 U.S.C. §103(a) as unpatentable over Sirhan et al. (U.S. Patent No. 5,743,875) in view of Javier, Jr. (U.S. Patent No. 6,093,177) further in view of Fontirroche et al. (U.S. Patent No. 5,538,510) and further in view of Berg et al. (U.S. Patent No. 5,792,116). Each of these secondary references have already been distinguished as failing to remedy the noted shortcomings of Sirhan et al. Favorable reconsideration is respectfully requested.

Applicants respectfully traverse the Examiner's rejection of claims 75-82, 87-90, 93, 95 and 99 under 35 U.S.C. §103(a) as unpatentable over Sirhan et al. (U.S. Patent No. 5,743,875) in view of Fontirroche et al. (U.S. Patent No. 5,538,510) and further in view of Ressemann et al. (U.S. Patent No. 5,571,087). Ressemann et al. fail to remedy the noted shortcomings of Sirhan et al. and Fontirroche et al., and therefore the rejection is flawed and should be withdrawn. Favorable reconsideration is respectfully requested.

Applicants respectfully traverse the Examiner's rejection of claims 83, 94, 96 and 100 under 35 U.S.C. §103(a) as unpatentable over Sirhan et al. (U.S. Patent No. 5,743,875) in view of Fontirroche et al. (U.S. Patent No. 5,538,510) further in view of Ressemann et al. (U.S. Patent No. 5,571,087) and further in view of Berg et al. (U.S. Patent No. 5,792,116). Each of these

secondary references have already been distinguished as failing to remedy the noted shortcomings of Sirhan et al. Favorable reconsideration is respectfully requested.

Applicants respectfully traverse the Examiner's rejection of claims 84, 85, 91 and 97 under 35 U.S.C. §103(a) as unpatentable over Sirhan et al. (U.S. Patent No. 5,743,875) in view of Fontirroche et al. (U.S. Patent No. 5,538,510), further in view of Ressemann et al. (U.S. Patent No. 5,571,087) and further in view of Javier, Jr. (U.S. Patent No. 6,093,177). Each of these secondary references have already been distinguished as failing to remedy the noted shortcomings of Sirhan et al. Favorable reconsideration is respectfully requested.

Applicants respectfully traverse the Examiner's rejection of claims 86, 92 and 98 under 35 U.S.C. § 103(a) as unpatentable over Sirhan et al. (U.S. Patent No. 5,743,875), in view of Ressemann et al. (U.S. Patent No. 5,571,087) further in view of Javier, Jr. (U.S. Patent No. 6,093,177) further in view of Fontirroche et al. (U.S. Patent No. 5,538,510) and further in view of Berg et al. (U.S. Patent No. 5,792,116). Each of these secondary references have already been distinguished as failing to remedy the noted shortcomings of Sirhan et al. Favorable reconsideration is respectfully requested.

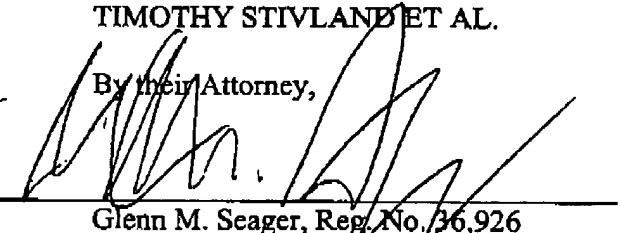
In view of the amendments and arguments presented herein, favorable reconsideration in the form of a Notice of Allowance is respectfully. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

TIMOTHY STIVLAND ET AL.

By their Attorney,

Date: July 26, 2005

  
Glenn M. Seager, Reg. No. 36,926  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, Minnesota 55403-2420  
Tel: (612) 677-9050